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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

12-11-95
In Re Appln. of: Robert Filepp et al.

Group Art Unit: 2301

Serial No.: 08/158,031

Examiner: M. Smith

Filed: November 26, 1993

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GROUP 240

Title: METHOD FOR PRESENTING APPLICATIONS
IN AN INTERACTIVE SERVICE

AMENDMENT

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

In response to the Official Action dated April 12, 1995, Applicants request that the following amendments be entered in their application, and that their application be reconsidered in light of those amendments and the related remarks presented below.

In the Claims:

~~1. (Twice Amended) A method for presenting applications of an interactive service provided on a computer network, the network including a multiplicity of user reception systems at which respective users may request a multiplicity of available service applications, the respective reception systems including a monitor at which the applications requested can be presented as one or more screens of display, the method comprising the steps of:~~

✓

~~a. generating a screen display at the respective reception systems for a requested application of the interactive service, the screen display including [that includes] a plurality of partitions, the partitions being constructed from information elements having a prescribed structure, the elements being stored in the network and retrievable at the respective reception system such that at least some of the elements may be used in more than one application [that may be reused];~~

~~b. generating at least a first partition for presenting applications; and~~

~~c. generating concurrently with the first partition at least a second partition for presenting a plurality of command functions, the command functions including at least a first group which are selectable to [manipulate the display of] permit movement between applications.~~

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Sub

E 2 > 2 (Twice Amended) The method of claim 1 wherein the elements for constructing the partitions are objects and wherein generating the second partition includes providing the first group of command functions with a first subgroup of command functions which are selectable to [randomly moving] permit random movement between applications.

3. (Twice amended) The method of claim 2 wherein providing the first subgroup of commands includes providing a command for causing the user to be presented with at least one [procedures] procedure for navigating to a new application.

REMARKS

In the Official Action dated April 12, 1995, the Examiner noted acceptance of the amendments to Applicants' abstract, drawings, specification and claims submitted

October 21, 1995. Additionally, the Examiner noted acceptance of the arguments presented with Applicants' October 21st amendments which arguments patentably distinguished Applicant pending claims over the art then of record. However, despite the acceptance of Applicants' amendments and arguments, the Examiner, has once again, rejected Applicants' pending claims, this time, on grounds of indefiniteness along with anticipation and obviousness in view of newly cited art.

Specifically, in the April 12th action, the Examiner rejected Applicants' claim 3 under 35 U.S.C. §112, second paragraph as indefinite in view of informalities contained in the claim. Additionally, the Examiner rejected Applicants' claims 1-5, 8, 9, and 12-17 under 35 U.S.C. §102(a) and claims 6, 7, 10, and 11 under 35 U.S.C. §103 in view of a newly cited user guide for Windows Version 2.0 published by Microsoft and carrying 1987 copyright notice.

With regard to the Examiner's rejection of Applicants' claim 3, under 35 U.S.C. §112, second paragraph, in his rejection, the Examiner noted that Applicants use of the phrase "at least one procedures" was vague. In reply, Applicants would respectfully point out that the informality in claim 3 was due to a typographical error. Inadvertently the word "procedures" was entered where the word "procedure" was intended. To correct this, Applicants have submitted an appropriate amendment.

Turning next to the Examiner's rejection of Applicants' claims on grounds of anticipation and obviousness, Applicants would respectfully submit that the rejections are improper both as a matter of fact and as a matter of law and, accordingly, they must be withdrawn.

First with respect to the Examiner's rejection of Applicants' claims 1-5, 8, 9 and 12-17 on grounds of anticipation in view of the newly cited Windows 2.0 user guide, Applicants would point out that the Windows user guide neither discloses nor suggests Applicants' claimed invention and, therefore, as a matter of law the cited user's guide is unable to render Applicants' claimed invention anticipated.

Applicants' invention as expressly recited in claim 1 is directed to a method for presenting applications of an interactive service in a computer network. The Windows user guide, however, makes absolutely no reference to an interactive service or presentation of interactive service applications in a network. Indeed, the Windows user guide solely describes Windows as a shell for conventional computer applications (see pg. viii, ix). Yet additionally, Applicants claim 1 expressly requires that, in accord with Applicants' invention, the interactive service applications are to be presented at screen partitions constructed using information elements that can be reused between applications. The Windows user guide, however, makes absolutely no reference to or suggestion of any special information elements for creation of the display partitions. Indeed, the user manual, rather, expressly notes that Windows operates with conventional DOS applications and conventional applications prepared for Windows (pg. ix).

Moreover, a reading of Applicants' specification makes it clear that Applicants have specifically selected the noted information elements to have a prescribed structure, preferably, data objects, and that at least some of the elements may be used in more than one application. Still further, in accordance with Applicants' teaching, the

elements may be stored in the interactive service network such that they can be retrieved for use in creating the application screen displays. And, as explained in Applicants' specification, this approach has been taken for the express purpose of providing display of the interactive service applications with minimal delay. In the cited Windows user guide, there is, simply, no suggestion or consideration of display delay in an interactive service or a solution to that problem as proposed by Applicants.

Indeed a reading of the Examiner's remarks in the April 12, 1995 action concerning reusability, makes it clear the Examiner has misunderstood Applicants teaching. In asserting the Windows user guide as an anticipation of Applicants' invention, the Examiner mistakenly refers to reuse of partitions (par. 3, ln 5 et seq.) not the information elements that make up the partitions. In fact, even if one were to accept the mistaken premise asserted by the Examiner; i.e., that it is the partition that are to be reused, instead of the information elements - under Windows operation - there is not even the reuse of partitions that the Examiner asserts. In Windows, a new window; i.e., partition, is created for each and every application that Windows presents. And further, as each application is extinguished, the associated Window, partition is extinguished and not reused.

Still further, in accord with Applicants' invention, commands are provided for moving between applications; as for example, in single display partition. No such teaching is provided in Windows. In Windows, rather than permitting navigation through applications presented at a single partition, Windows merely permits "selection" from the multiple Windows required to be opened where multiple

applications are sought to be presented. As is immediately apparent to anyone who has tried to view multiple applications in a Windows environment, screen clutter and obscurity of application content is a substantial problem and not to be compared with movement between applications as proposed by Applicants.

Accordingly, a reading of Applicants claim 1 makes it clear there is no factual basis for contending the elements of Applicants' invention can be found in the newly cited Microsoft Windows user guide. And accordingly, as a matter of law, there is, therefore, no basis for contending Applicants' claim 1 is anticipated by the Windows user guide.

The Court of Appeals for the Federal Circuit (CAFC) and its predecessor, the Court of Customs and Patent Appeals (CCPA), have repeatedly stated that for a prior art reference to anticipation a claimed invention under 35 U.S.C. §102, each and every element of the claimed invention must appear in the single reference. *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (Fed Cir 1988). Further, the CAFC has pointed out that the elements of the claimed invention must be arranged in the reference as they are in the claimed invention in order to establish an anticipation. *Lindemann Maschinenfabrik v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed Cir 1984).

Therefore, because the Windows user guide fails to disclose or suggest a method for presenting application of an interactive service in a network, or use of specially structured information elements, at least some of which may be used in constructing partitions for presenting more than one application, or storage of such elements in the

network for retrieval in creating the displays, or commands for moving between the applications, the users guide can not be considered to anticipate Applicants' claimed invention. Moreover, since each of Applicants other claims depend from claim 1, and accordingly, include each and every limitation of claim 1 in addition to the further limitation recited by the respective dependent claims, at least for the reasons noted above regarding claim 1, none of Applicants' other claims can be anticipated by the cited user guide.

Accordingly, the Examiner's rejections of Applicants' claims 1-5, 8, 9, and 12-17 as anticipated by under 35 U.S.C. §102 (a) is improper and must be withdrawn.

Continuing, in addition to contending that the above noted of Applicants' claims are anticipated, by the Microsoft Windows user guide, the Examiner further contends that other of Applicants' claim, specifically, claims 6, 7, 10, and 11, while not anticipated by the user guide, are nonetheless unpatentable as being obvious in view of the Windows user guide teaching. Once again, the Examiner's assertions are without foundation both as a matter of fact and as a matter of law.

In Applicants' claims 6, 7, 10, and 11, in addition to including the above-noted limitations concerning presentation of interactive service applications and use of specialty information elements for construction of the display partition, the noted dependent claims further include limitation to navigation; i.e. movement through applications of the interactive service. Accordingly, for the reasons noted above concerning failure of the Windows user guide to address navigation through multiple applications, Windows, instead, teaching movement between multiple windows, each

window fixedly associated with an application, the user guide can not be considered to render Applicants' proposed navigation methods obvious. Indeed in view of the difference between the two approaches, i.e., Applicants teaching movement through multiple applications, preferably at a single partition, and the Windows approach of moving between multiple partitions, each including its own, separate and distinct application, the Windows guide must be seen to, in fact, teach away from Applicants' approach.

Still further, even if the Windows approach of creating multiple partition, i.e., windows, for the multiple applications, were considered to have some relevance to Applicants' teaching, still, the Windows guide fails entirely to suggest or disclose the indexed or directory navigation of applications or the use of predetermined progression of transitions; i.e., "path", through applications as taught by Applicants. Rather, at best, the Windows guide proposes simple, user-directed, manual movement between multiple Windows; as for example, as effected by visual and manual selection using a pointing device; i.e., a mouse. (pg. viii of the guide). As would be apparent to one skilled in the art, these two approach are fundamentally different. The Windows procedure takes a simplistic approach of proposing manual and visual selection between the limited number of partitions that can be physically accommodated on a display screen, while Applicants' approach is that of a structured, database-type navigation through a potentially, large number of unseen applications.

As a result, as a matter of law, there is no factual basis for contending that once having seen the Windows approach one would be led to the approach proposed by

Applicants. As pointed out by the Court of Appeals for the Federal Circuit in considering invention including known elements:

It is not "features" but subject matter of the invention "as a whole" that must be considered under, 35 U.S.C. 103. That features, even distinguishing features, are "disclosed" in the prior art is alone insufficient. As above indicated, it is common to find elements or features somewhere in the prior art. Moreover, most if not all elements perform their ordinary and expected function. The test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. 35 U.S.C. 103.

Connell v. Sears, Roebuck and Company, 220 USPQ 193, 199 (Fed. Cir. 1983).

Accordingly, at least because the Windows guide fails to disclose or suggest predetermined procedure such as indexing, directory formulation or predetermine sequenced progression, as recited in Applicants' claims, the teaching of the Windows guide is unable to render Applicants' claims 6, 7, 10 and 11 unpatentable.

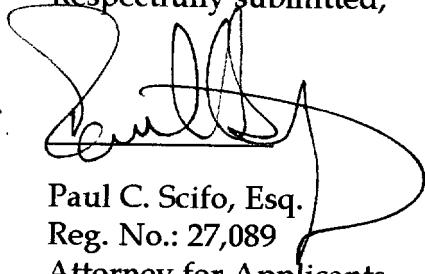
Still further, since it would be impossible to undertake navigation using procedures proposed in the Windows user guide to effect navigation as proposed by Applicants without making fundamental design changes to the Windows procedures; for example, inclusion of a procedures for enabling predetermined navigation strategies, procedures that are nowhere suggested in the Windows user guide, the cited reference not only fail to suggest Applicant's invention but, in fact and as noted, teaches away from it. *In re. Gordon*, 221 USPQ 1125 (Fed. Cir. 1984), *In re. Schulpen*, 157 USPQ 52 (CCPA 1968). Accordingly, for the reasons noted above as to why the Windows user guide can not be considered to disclose or suggest the elements of Applicants main claims or Applicants' dependent claims, the Windows use guide can not be considered to render Applicant's invention as claimed obvious.

However, while Applicants believe their invention as claimed is distinguished over the art, in an effort to further clarify those distinctions and to move their application to allowance, Applicants have amended their claim 1 to point out that their application display partitions are constructed from information elements of prescribed structure which may be reused and which are located in the network for recall. Support for the amendments to claim 1 can be found at least at pg. 15, lns.25 to pg. 24, ln. 32, and pg. 29, ln. 30 to pg. 40, ln 7.

Accordingly, in view of the noted amendments and preceding remarks, Applicants would respectfully submit that their invention is patentably distinguished from the art cited, and, that all objections raised by the Examiner have been resolved. Therefore, Applicants, requests reconsideration of their application and issuance of a patent thereon.

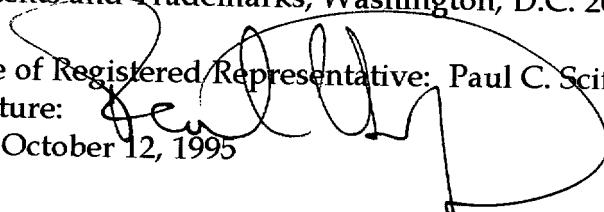
Dated: October 12, 1995,

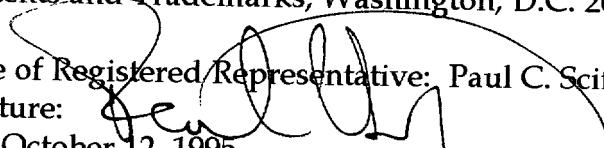
Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231, on October 12, 1995.



Name of Registered Representative: Paul C. Scifo, Esq.
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TRANSMITTAL LETTER

The Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

In connection with the above referenced application, I am enclosing herewith:

I. A reply to the Office Action of April 12, 1995, the reply including:

1. An amendment of 10 pages;
2. A petition to extend the time to reply by three months; and
3. An attorney check in the amount of \$900 to cover the extension fee.

No amendment fee is required based on the following calculation:

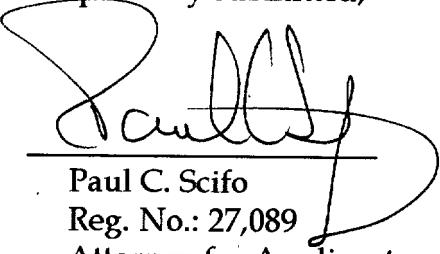
| | CLAIMS REMAINING HIGHEST NO. AFTER AMENDMENT | EXTRA PREV. PAID | RATE | FEE |
|--------------|---|---------------------|--------|------|
| TOTAL: | 17 | 20 | 22.00 | \$ 0 |
| INDEP. | 1 | 3 | 78.00 | \$ 0 |
| MULTIP. DEP. | 1 | 1 | 250.00 | \$ 0 |
| | | | TOTAL | \$ 0 |

The Commissioner of Patents and Trademarks
October 12, 1995
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In the event there are any questions concerning these items, please feel free to contact me during business hour either by telephone at (212) 513-1122, or by FAX at (212) 513-1123. Your assistance is appreciated.

Dated: October 12, 1995,

Respectfully submitted,


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I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope address to the Commissioner of Patents and Trademarks, Washington, D.C., 20231 on October 12, 1995.

Name of Registered Representative: Paul C. Scifo, Esq.

Signature: 

Date: October 12, 1995.